

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Nemoto *et al.*

Appl. No.: 10/566,573
(U.S. National Phase of PCT/JP04/11308)

Int'l Filing Date: July 30, 2004

For: **Methods of Screening for Useful
Proteins (as amended)**

Confirmation No.: 3545

Art Unit: *To Be Assigned*

Examiner: *To Be Assigned*

Atty. Docket: 2144.0330000/RWE/RAS

Information Disclosure Statement Under 37 C.F.R. § 1.97(b)

Mail Stop Amendment

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on accompanying IDS Forms, PTO/SB/08A and PTO/SB08B, are documents that may be considered material to the examination of this application, in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.56, 1.97 and 1.98. Copies of documents **FP1** to **FP4** and **NPL1** to **NPL11** are submitted.

In accordance with 37 C.F.R. § 1.98(a)(3), Applicants' undersigned representative submits the following discussion of the relevance of the non-English language documents **FP1**, **FP3**, **FP4**, and **NPL6** cited on PTO/SB/08A and PTO/SB/08B:

Document **FP1**, WO 01/16600 A1, is in the Japanese language. An English language equivalent of document FP1 is attached as Document **FP2**.

Documents, **FP3**, **FP4**, and **NPL6** were cited in a search report by a foreign patent office in a counterpart foreign application. Submission of an English language

version of the search report that indicates the degree of relevance found by the foreign office is provided in satisfaction of the requirement for a concise explanation of relevance. 1138 OG 37, 38.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached IDS Forms based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits. No statement or fee is required.

It is respectfully requested that the Examiner initial and return a copy of the enclosed IDS Forms, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: June 5, 2006

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535286v1

FOREIGN PATENT DOCUMENTS					
Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	T ⁶
		Country Code ³ Number ⁴ Kind Code ⁵ (if known)			
	FP1	WO 01/16600 A1	03/08/2001	Mitsubishi Chemical Corporation	Yes
	FP2	EP 1 211 514 A1	06/05/2002	Mitsubishi Chemical Corporation	
	FP3	JP 2003-500066	01/07/2003	Ikutsuirion GmbH & Co. KG.	ISR
	FP4	JP 2003-189878	07/08/2003	Takeda Chemical Industries, Ltd.	ISR

Examiner Signature		Date Considered	
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Substitute for form 1449/PTO				Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)				Application Number (Nat'l Phase of PCT/JP04/11308)	10/566,573
				Int'l Filing Date	July 30, 2004
				First Named Inventor	Naoto Nemoto
				Art Unit	To Be Assigned
				Examiner Name	To Be Assigned
Sheet	1	of	2	Attorney Docket Number	2144.0330000/RWE/RAS

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume issue number(s), publisher, city and/or country where published	T ²
	NPL1	Eigen, M. and Gardiner, W., "Evolutionary Molecular Engineering Based on RNA Replication," <i>Pure Appl. Chem.</i> 56:967-978, Pergamon Press Ltd. (1984)	
	NPL2	Ellington, A.D. and Szostak, J.W., "In vitro selection of RNA molecules that bind specific ligands," <i>Nature</i> 346:818-822, Nature Publishing Company (1990)	
	NPL3	Fodor, S.P.A., et al., "Light-Directed, Spatially Addressable Parallel Chemical Synthesis," <i>Science</i> 251:767-773, American Association for the Advancement of Science (1991)	
	NPL4	Mattheakis, L.C., et al., "An in vitro polysome display system for identifying ligands from very large peptide libraries," <i>Proc. Natl. Acad. Sci. USA</i> 91:9022-9026, National Academy of Sciences (1994)	
	NPL5	Nemoto, N., et al., "In vitro virus: Bonding of mRNA bearing puromycin at the 3'-terminal end to the C-terminal end of its encoded protein on the ribosome in vitro," <i>FEBS Lett.</i> 414:405-408, Elsevier Science B.V. (1997)	
	NPL6	Oshima, Y., "Tanpakushitsu no Tainetsu Sekkei," <i>Kagaku Kogyo</i> 38:223-226, Chemical Society of Japan (1987)	ISR
	NPL7	Scott, J.K. and Smith, G.P., "Searching for Peptide Ligands with an Epitope Library," <i>Science</i> 249:386-390, American Association for the Advancement of Science (1990)	
	NPL8	Tabuchi, I., et al., "An in vitro DNA virus for in vitro protein evolution," <i>FEBS Lett.</i> 508:309-312, Elsevier Science B.V. (2001)	
	NPL9	Tuerk, C. and Gold, L., "Systematic Evolution of Ligands by Exponential Enrichment: RNA Ligands to Bacteriophage T4 DNA Polymerase," <i>Science</i> 249:505-510, American Association for the Advancement of Science (1990)	
	NPL10	Copy of International Search Report for International Patent Application No. PCT/JP2004/011308, Japanese Patent Office, JP, mailed September 14, 2004	

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Examiner Signature		Date Considered	
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹ Applicant's unique citation designation number (optional). ² Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT <i>(Use as many sheets as necessary)</i>				Complete if Known		
				Application Number (Nat'l Phase of PCT/JP04/11308)		10/566,573
				Int'l Filing Date		July 30, 2004
				First Named Inventor		Naoto Nemoto
				Art Unit		To Be Assigned
				Examiner Name		To Be Assigned
Sheet	2	of	2	Attorney Docket Number		2144.0330000/RWE/RAS

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume number, publisher, city and/or country where published	T ²
	NPL11	Copy of International Preliminary Report on Patentability for International Application No. PCT/JP2004/011308, Japanese Patent Office, JP, June 14, 2005	

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